IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Cary Douglas, Lei Fu, and Tarak D. Mody) Group Art Unit:Not Yet Assigned
International Application No.: PCT/US2003/037888 USSN 10/537379) Examiner: Not Yet Assigned)
Filed: June 3, 2005) Conf. No. 4899
Title: Preparation of Metallotexaphyrins)

Certificate of Electronic Filing

I hereby certify that the attached Petition for Acceptance of Corrected International Application number and US Serial Number and all marked attachments are being deposited by Electronic Filing on August 8, 2006 by using the EFS – Web patent filing system and addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: Ann Lygas

Date: <u>August 8, 2006</u>

PETITION FOR CORRECTION TO INVENTORSHIP UNDER 37 CFR 1.182, OR, IN THE ALTERNATIVE, PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Mail Stop PCT – LEGAL Attention: Leonard Smith Assistant Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

The Commissioner is hereby petitioned to accept the corrected international application number, PCT/US2003/037888, as the priority document and to keep the U.S. Serial Number 10/537379 and the filing date of June 3, 2005 assigned to it on the return postcard. A copy of the post card indicating the Commissioner issued a filing date of June 3, 2005 and a US Serial Number of 10/537379, a copy of the Certificate of Mailing Under 37

CFR 1.10 and Express Mail Label No. EV517729605US, a copy of the application data sheet, a copy of the original transmittal letter, and a copy of the corrected transmittal are enclosed.

The Application Data Sheet, Certificate of Mailing Under 37 CFR 1.10 filed on June 3, 2005, and page 2 of the original transmittal letter submitted with the application to the national phase division of the United States Patent and Trademark Office contain the correct international application number. Applicant mistyped the international application number on the first page of the transmittal letter (PTO Form 1390); the first page of the Preliminary Amendment, and on the first page of the Information Disclosure Statement. Applicant telephoned the national phase division upon awareness of this error. It was suggested that a new transmittal letter with a copy of the correct priority document be faxed to (571) 270-9774. Applicant prepared and faxed in these documents on June 7, 2006.

A review of 10/537,379 in Private PAIR does not show the correct International Application Number/priority document.

The corrected transmittal letter for international application number PCT/US2003/037888 was faxed to the national phase division at the USPTO on June 7, 2006. Correct international application number PCT/US2003/037888 does appear on the Application Data Sheet, the Certificate of Mailing under 37 CFR 1.10, and the 2nd page of the original transmittal letter filed with the application on June 3, 2005. There were some typographical errors identifying an incorrect application number, but the correct application number does appear in several documents submitted with the application at the time of filing. Accordingly, Applicant petitions that the Application Data in Private PAIR be corrected to reflect the correct international application number, PCT/US2003/037888, as the priority document and that the 5 pages of Documents Submitted with 371 Applications in the Image File Wrapper be corrected to reflect the correct priority document, WO2004/050716 A2.

In the event that this Petition under 37 CFR 1.182 is denied, Applicant, in the alternative, Petitions for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b), as the delay in filing these application papers was unintentional.

25922-706.201

The Commissioner is hereby authorized to charge any fees which may be required by this paper, or credit any overpayment to Deposit Account No. 23-2415 (Docket No. 25922-706.201). Applicant claims small entity status under 37 CFR 1.27.

Respectfully submitted,

Jeffrey W. Guise

Registration No. 34,613

Q 7 66 Date

WILSON SONSINI GOODRICH & ROSATI 650 Page Mill Road Palo Alto, CA 94304

Telephone: (650) 493-9300

			Date: June 7, 2006
To: U.S. Patent & Trademark Office	Fax: (571) 270-9	774	Use this fax number only
Company:	Phone:		Notify recipient before sending
From: Michael Hostetler	Phone: (858) 350-2306	Return Fax:	(858) 350-2399
Original: To follow via mail To fo	ollow via courier To follow via	a email 🖂 C	Original will not follow
Fax Contains: 3 pages (including this sheet). If incomplete, call Linda Thompsor	n at 858-350-2345	5.
Message:			
RE: Application No.: 10/537,379 Michael J. Hostetler, Reg. No. 47,	,664		
Corrected Transmittal Letter and cover page of	priority document attached.		
Thank you.			

Return Original to: Linda Thompson

Location: SD

12235 El Camino Real, Suite 200, San Diego, CA 92130-3002 858.350.2300 Tel • 858.350.2399 Fax • www.wsgr.com

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Ref: 25922-706.201

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06/07 10:42 915712709774 00:00:57 03 OK STANDARD ECM

PTO-1390 (Rev. 02-2005)

pproved for use through 3/31/2007. OMB 0651-0021
U.S. Patent and ... Jemark Office; U.S. DEPARTMENT OF COMMERCE to a collection of information unless it displays a wall of the commerce of the control of the

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TRANSMITTAL LETTER TO THE UNITED STATES		ATTORNEY 'S DOCKET NUMBER					
	DESIGNATED/ELECTED OFFICE (DO/FO/US)		25922-706.201				
C	ONCERNING A SUBMISSION		U.S. APPLICATION NO. (If known, see 37 CFR 1.5)				
	IATIONAL APPLICATION NO.		Not yet assigned				
	IS2003/037888	INTERNATIONAL FILING DATE 24 Nov. 2003	PRIORITY DATE CLAIMED 04 Dec.2002				
TITLE O	F INVENTION		104 DG0.2002				
PREP/	ARATION OF METALLOTEXAPHY	RINS					
	ANT(S) FOR DO/EO/US DOUGLAS; Lei FU; and Tarak D. MC	ODV					
			O/US) the following items and other information:				
1. X	This is a FIRST submission of items conce						
2.	This is a SECOND or SUBSEQUENT subr	_					
3.			371(f)). The submission must include items				
_	(5), (6), (9) and (21) indicated below.	•	, (V),				
4. 🛛	The US has been elected (Article 31).						
5. 🛚	A copy of the International Application as f	, , , , , ,					
		y if not communicated by the Internationa	al Bureau).				
	b. has been communicated by the I						
· 🗆		n was filed in the United States Receiving					
6.	An English language translation of the Inte	rnational Application as πιεα (3ວ ບ.ຣ.ບ.	371(c)(2)).				
	a. is attached hereto.	- I OF ILO O AEA/AVAN					
7. 🛛	b. has been previously submitted up	, , ,					
/. KA	Amendments to the claims of the Internation						
		ally if not communicated by the Internation	nal Bureau).				
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9.	An oath or declaration of the inventor(s) (35		e 19 (35 U.S.C. 37 1(C)(3)).				
10.	An English language translation of the anne		amination Report under PCT				
_	Article 36 (35 U.S.C. 371(c)(5)).		initiation report under 1 01				
	ns 11 to 20 below concern document(s) or						
11. 🛛	An Information Disclosure Statement under						
12.	— The state of the						
13. 🖂	A preliminary amendment.						
14. 🛚	An Application Data Sheet under 37 CFR 1	76.					
15.	A substitute specification.						
16.	A power of attorney and/or change of address letter.						
17.	A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821- 1.825.						
18.	A second copy of the published International Application under 35 U.S.C. 154(d)(4).						
19. 🗌	A second copy of the English language translation of the International Application under 35 U.S.C. 154(d)(4).						
20. 🛛	Other items or information: Return Receipt Postcard						

This collection of information is required by 37 CFR 1.414 and 1.491-1.492. The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 15 minutes to complete, including gathering information, preparing, and submitting the completed form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

(19) World Intellectual Property Organization

International Bureau



(43) International Publication Date 17 June 2004 (17.06.2004)

PCT

(10) International Publication Number WO 2004/050716 A2

(51) International Patent Classification7:

C08F

(21) International Application Number:

PCT/US2003/037888

(22) International Filing Date:

24 November 2003 (24.11.2003)

(25) Filing Language:

English

(26) Publication Language:

English

(30) Priority Data:

60/431,157 60/480,600 4 December 2002 (04.12.2002) US 19 June 2003 (19.06.2003) US

(71) Applicant (for all designated States except US): PHAR-MACYCLICS, INC. [US/US]; 995 E. Arques Avenue, Sunnyvale, CA 94085 (US).

(72) Inventors; and

- (75) Inventors/Applicants (for US only): DOUGLAS, Cary [US/US]; 192 Park Street, San Francisco, CA 94110 (US). FU, Lei [CN/US]; 34254 Quartz Terrace, Fremont, CA 94555 (US). MODY, Tarak, D. [US/US]; 955 La Mesa Terrace, #B, Sunnyvale, CA 94086 (US).
- (74) Agent: KATHARDEKAR, Vinit, G.; Pharmacyclics, Inc., 995 E. Arques Avenue, Sunnyvale, CA 94085 (DE).

(81) Designated States (national): AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EC, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NI, NO, NZ, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW.

(84) Designated States (regional): ARIPO patent (BW, GH, GM, KE, LS, MW, MZ, SD, SL, SZ, TZ, UG, ZM, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HU, IE, IT, LU, MC, NL, PT, RO, SE, SI, SK, TR), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN, TD, TG).

Declaration under Rule 4.17:

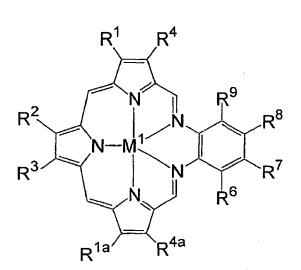
of inventorship (Rule 4.17(iv)) for US only

Published:

 without international search report and to be republished upon receipt of that report

For two-letter codes and other abbreviations, refer to the "Guidance Notes on Codes and Abbreviations" appearing at the beginning of each regular issue of the PCT Gazette.

(54) Title: PREPARATION OF METALLOTEXAPHYRINS



(57) Abstract: The present invention provides a process for replacing a metal cation, M^1 , from a compound of Formula I.

WO 2004/050716 A2

Title:	JC10 Reč'd PCT/PTO 03 JUN 2005
Inventors/Applicant:	10/537379
Application Serial No:	Filing Date:
Type of Application: Provisional Original	CIP Continuation Divisional PCT
☐ Transmittal Letter to the DO/EO/US Concerning a Filing Under 35 USC 371 including fee sheet and authorization to charge deposit account ☐ Missing Parts of Application Transmittal ☐ Declaration/Oath ☐ Decl./Power of Atty ☐ . ɔwer of Attorney ☐ Pwr of Atty by Assignee ☐ Assignment/Form PTO-1595 ☐ PCT In *rnational Appln Request Form ☐ pages ☐ PCT Transmittal ☐ pages ☐ Specification ☐ pages ☐ Claims ☐ pages ☐ Abstract ☐ pages ☐ Drawings ☐ Drawings ☐ pages	☐ Fee Transmittal ☐ Extension of Time fee \$ ☐ RCE fee \$ ☐ RCE fee \$ ☐ RCE fee \$ ☐ Independ. claims in excess \$ ☐ Independ. claims in excess \$ ☐ Other fee () \$ ☐ Request for Corrected Filing Receipt ☐ Information Disclosure Statement ☐ Form PTO/SB/08 with 1 ref(s) ☐ Preliminary Amendment ☐ Extension of Time fee \$ ☐ RCE fee \$ ☐ Other fee () \$ ☐ Chapter II Demand/Fee Sheet ☐ Response-Invitation to Correct ☐ Article 19 Amendment ☐ Article 34 Amendment ☐ Response to Written Opinion ☐ RCE Transmittal ☐ Issue Fee ☐ Formal Drawings
⊠ Express Mail Certificate No: EV 517729605 US □ First Class Mail ☑ Authorization to Charge Deposit Account No. 23-2415	☑ Other: APPLICATION DATA SHEET
Attorney Docket No. 25922-706.201 Attorney: Michael J. Hostetler	Date Mailed: June 3, 2005

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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.10

Re:

International Application No. PCT/US2003/037888

Applicants:

Cary Douglas et al. (Pharmacyclics, Inc.)

Our file:

25922-706.201

Express Mail Label No. EV 517729605 US

Date of Deposit June 3, 2005

This paper and those indicated below as being attached are being deposited with the United States Postal Service's "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and are addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Attachments:

- 1. <u>Transmittal Letter to the DO/EO/US Concerning a Filing Under 35 U.S.C. 371 including fee sheet and authorization to charge deposit account;</u>
 - 2. Application Data Sheet
 - 3. Preliminary Amendment
 - 4. Information Disclosure Statement and Form PTO/SB/08A with (1) reference.

Approved for use through 3/31/2007, OMB 0651-0021 U.S. Patent and Trademark (: U.S. DEPARTMENT OF COMMERCE it displays a valid OMB control number. ATTORNEY'S DOCKET NUMBER TRANSMITTAL LETTER TO THE UNITED STATES 25922-706.201 DESIGNATED/ELECTED OFFICE (DO/EO/US) U.S. APPLICATION NO. (If known, see 37 CFR 1.5) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371 Not yet assigned INTERNATIONAL APPLICATION NO. INTERNATIONAL FILING DATE PRIORITY DATE CLAIMED PCT/US2003/03788 24 Nov. 2003 04 Dec.2002 TITLE OF INVENTION PREPARATION OF METALLOTEXAPHYRINS APPLICANT(S) FOR DO/EO/US Cary DOUGLAS; Lei FU; and Tarak D. MODY Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information: 1. This is a FIRST submission of items concerning a submission under 35 U.S.C. 371. 2. This is a SECOND or SUBSEQUENT submission of items concerning a submission under 35 U.S.C. 371. This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below. The US has been elected (Article 31). A copy of the International Application as filed (35 U.S.C. 371(c)(2)) a. I is attached hereto (required only if not communicated by the International Bureau). has been communicated by the International Bureau. c. is not required, as the application was filed in the United States Receiving Office (RO/US). 6. An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)). a. is attached hereto. has been previously submitted under 35 U.S.C. 154(d)(4). 7. Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)) are attached hereto (required only if not communicated by the International Bureau). have been communicated by the International Bureau. have not been made; however, the time limit for making such amendments has NOT expired. have not been made and will not be made. 8. An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)). 9. An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)). 10. An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)). Items 11 to 20 below concern document(s) or information included:

11. An Information Disclosure Statement under 37 CFR 1.97 and 1.98.

12. An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.

13. A preliminary amendment.

14. An Application Data Sheet under 37 CFR 1.76.

A substitute specification.

16. A power of attorney and/or change of address letter.

17. A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821-1.825.

18. A second copy of the published International Application under 35 U.S.C. 154(d)(4).

19. A second copy of the English language translation of the International Application under 35 U.S.C. 154(d)(4).

20. Other items or information: Return Receipt Postcard

This collection of information is required by 37 CFR 1.414 and 1.491-1.492. The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 15 minutes to complete, including gathering information, preparing, and submitting the completed form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

PTO-1390 (Rev. 02-2005)
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ľ	J.S. APPLICATION NO. (if known, see 37 CFR 1.5) INTERNATIONAL APPLICATION NO.				ATTORNEY'S DOCKET NUMBER		
Not yet assigned PCT/US2003/037888 The following fees are submitted:				25922-706.201			
		CALCULATIONS	PTO USE ONLY				
				\$300	\$ 300.00		
If International prelin	nation fee minary examination re (1)-(4)	aport prepare	ed by USPTO and al aims satis	ify provisions of	\$ 100.00		
All other situations	1)-(4)		·····	\$200			
23. X Search	fee						
Search fee (37 CFR	(1.445(a)(2)) has bee	n paid on the	e international application to the	e USPTO as an			
International Search	h Report prepared and	d provided to	the Office	\$400			
All other situations		· · · · · · · · · · · · · · · · · · ·			\$ 100.00		
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Total claims	26	-20 = (6	X \$50	\$ 300.00		
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			TOTAL OF ABOVE CA	ALCULATIONS =			
Applicant claim	ns small entity status. S	ee 37 CFR 1.	.27. Fees above are reduced by		\$		
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Claimed priority cane.	STOLK LIGHT		TOTAL N	IATIONAL FEE =	\$		
	e enclosed assignment over sheet (37 CFR 3.2		21(h)). The assignment must be	accompanied +	\$		
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CUSTOMER NO). 021971		<u> </u>	SIGNATURE /			
	Michael J. Hostetler						
			N	IAME			
				17,664 REGISTRATION NUM	ARFR	,	

Application Data Sheet

Application Information

Application Type::

Regular

Subject Matter::

Utility

Suggested Group Art Unit::

Not yet assigned

CD-ROM or CD-R?::

None

Title Line One::

PREPARATION OF

Title Line Two::

METALLOTEXAPHYRINS

Attorney Docket Number::

25922-706.201

Request for Early Publication?::

No

Request for Non-Publication?::

No

Total Drawing Sheets::

Small Entity::

No

Petition included?::

No

Secrecy Order in Parent Appl.?::

No

Applicant Information

Applicant Authority type::

Inventor

Primary Citizenship Country:

US

Status::

Full Capacity

Given Name::

Cary

Family Name::

DOUGLAS

City of Residence::

Osaka

Country of Residence::

Japan

Street of mailing address::

Takeda Yodogawa Heim A #801

City of mailing address::

Yodogawa-ku Nitaka 6-14-8

State or Province of mailing address::

Osaka, Japan

Postal or Zip Code of mailing address:: 532-0033

Applicant Authority type::

Inventor

Primary Citizenship Country:

CHINA

Status::

Full Capacity

Given Name::

Lei

Family Name::

FU

City of Residence::

Freemont

State of Province of Residence::

CA

Country of Residence::

US

CA

Street of mailing address::

34254 Quartz Terrace

City of mailing address::

Freemont

State or Province of mailing address::

Postal or Zip Code of mailing address:: 994555

Applicant Authority type::

Inventor

Primary Citizenship Country:

US

Status::

Full Capacity

Given Name::

Tarak D.

Family Name::

MODY

City of Residence::

Sunnyvale

State of Province of Residence::

CA

Country of Residence::

US

Street of mailing address::

955 La Mesa Terrace, #E

City of mailing address::

Sunnyvale

State or Province of mailing address::

CA ·

Postal or Zip Code of mailing address:: 94086

Correspondence Information

Correspondence Customer Number::

021971

Representative Information

Representative Customer Number:	021971	
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Domestic Priority Information

Application::	Continuity Type:	Parent Application::	Parent Filing Date::
This Application	National Stage of	PCT/US2003/037888	11/24/03
PCT/US2003/037888	An application claiming the benefit under 35 USC 119(e)	60/431157	12/4/02
PCT/US2003/037888	An application claiming the benefit under 35 USC 119(e)	60/480,600	6/19/03

Assignee Information

Assignee Name::

Pharmacyclics, Inc.